



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/272,845	03/19/1999	DOUGLAS L ROLLINS	MICE-0017-US	6156

7590 02/06/2002

COE F MILES  
TROP PRUNER HU & MILES  
8554 KATY FREEWAY STE 100  
HOUSTON, TX 77024

EXAMINER

KENDALL, CHUCK O

ART UNIT

PAPER NUMBER

2122

DATE MAILED: 02/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/272,845	ROLLINS, DOUGLAS L
Examiner	Art Unit	
Chuck O Kendall	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 January 2002.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-44 is/are rejected.

7) Claim(s) 38 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                            4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                            5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                            6) Other: \_\_\_\_\_

**DETAILED ACTION**

**RESPONSE TO AMENDMENT**

1. This Office Action is the response to the communication received on January 15, 2002 Amendment under 37 CFR § 1.111. Reconsideration of the instant application is requested by applicants. All such supporting documentation has been placed of record in the file. Claims 1-44 are pending in this application. The amendment filed is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Using the date to establish compatibility between second and first programs in claims 41 & 43. Applicant is required to cancel the new matter in the reply of this Office action.

2.

*Response to Arguments*

Regarding rejection of the claims 1-44 under 35 U.S.C. §103(a) & §102(a): Examiner has evaluated applicant's arguments of January 15<sup>th</sup> correspondence which has been fully considered is not persuasive to overcome the previous rejection aforementioned, 35 U.S.C. §102(a) & § 103(a) per, pages 2-7 with previous cited references *Apfel et al.* For purpose of examining claim 38 will be referred to as claim 39. Examiner interprets using the date to establishing compatibility between second and first programs as upgrading depending on later date.

*Claim objection*

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are

Art Unit: 2122

canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Claim 39 was misnumbered as 38. Correction is needed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41, & 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification doesn't show using the date to establish compatibility between second and first programs.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 33-40 are rejected under 35 U.S.C. 102(a) as being anticipated by Apfel et al.

US-PAT-NO: 5974454 hereinafter Apfel.

*Regarding claims 33* Apfel shows, a computer executed method to update a software module, comprising (fig 4a), identifying a software module (2:62-64) automatically obtaining version information of the software module from a local source (2:62-64, see version of software module on computer), automatically obtaining version information of the software module from a non-local source; [refer to 11:66-67, also see fig 4a, part # 427, note: by definition an upgrade is a more current version of software than the prior version], comparing the version information from the local source with the version information from the non-local source, (11: 62-64, see older than user's version) and automatically retrieving an update module for the software module if the version information from the non-local source is newer than the version information from the local source.(3:25-28)

*Regarding claim 34* the method of claim 33, wherein the act of retrieving further comprises updating the software module with the retrieved update module. [abstract, also see fig 4a part # 451].

*Regarding claim 35* the method of claim 33, further comprising automatically updating the software module with a local update module obtained from a local media source if the version information from the local source is newer than the version information from the non-local source. [abstract, 11:32-34].

*Regarding claim 36* the method of claim 33, wherein the act of obtaining version information from a local source comprises, obtaining version information from a registry file. [fig 4b part#406, also see abstract].

*Regarding claim 37* the method of claim 33, obtaining version information from a local source comprises, obtaining version information from a local floppy disk. [see fig1,part # 29, also see 4:25-30, with respect to abstract]

*38*  
*Regarding claim 39* the method of claim 33, wherein the act of obtaining version information from a non-local source comprises, obtaining version information from a website. [also fig2 part #75a, also see 11:20-25]

*Regarding claim 39* as interpreted see reasoning in 38.

Art Unit: 2122

*Regarding claim 40 the method of claim 33, wherein the act of obtaining version information from a non-local source comprises, obtaining version information from dial-in server. [dial-in server is interpreted as a modem, fig 1,part #54.also see 5:13 and 11:32-34].*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8-22,24-32, 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al. US-PAT-NO: 5974454 hereinafter Apfel in view of Furner et al. USPN 5,974,474 hereinafter Furner.

Apfel as modified discloses updating a software module, by identifying a first version of the software module (11: 64-65, see user's version),identifying a second version of the software module, (11: 62-64, see later version) automatically determining whether the second version is more current than the first version (11: 62-64, see older than user's version), and indicating that version of the software module determined to be most current.(11:66-67, also 7:18-20 for compatibility of upgrades). Apfel doesn't expressly disclose software module being associated with circuitry [hardware device as taught in applicants specification page, 4 lines 21-22]. However, Furner does disclose software module being installed on a computer system and being associated with circuitry of the computer system other wise known as device driver. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify teachings of Apfel to

install device a driver as taught by Furner because, configuring device drivers from remote locations improves ease of modification.

*Regarding claims 2, &18 as disclosed in claim 1, further comprising obtaining that version of the software module determined to be the most current version. [Apfel refer to 11:66-67, also see fig 4a, part # 427, note: by definition an upgrade is a more current version of software than the prior version]*

*Regarding claims 3& 19 as disclosed in claim 2, further comprising loading the obtained version of the software module. [Apfel see fig 4b, part # 448, 454 for downloading upgrade and installing upgrade]*

*Regarding claims 4, &20 as per claim 1, wherein the act of identifying a first version of the software module comprises communicating with a physical device associated with the software module.[Furner 5:30-35]*

*Regarding claims 5, &21 as per claim 4, wherein the act of communicating comprises determining an identifier value of the physical device. [Furner 5: 30-40].*

*Regarding claims 6,&22 as disclosed in claim 5, further comprising determining a subsystem identifier value of the physical device [Furner 5: 30-40].*

*Regarding claims 8,&24 method of claim 1, wherein the act of identifying a second version of the software module comprises communicating with an update information source. [Apfel abstract, see transmit query via the internet to database server, also see item# 433,& 439 from fig 4b].*

*Regarding claims 9,&25 the method of claim 8, wherein the act of communicating further comprises:*

*identifying the software module to the update information source;[Apfel 2:62-64].*

receiving, from the update information source, an indication of the second version of the software module. [Apfel 2:52-54]

*Regarding claims 10, & 26* the method of claim 8, wherein the act of communicating comprises communicating by a modem.[Apfel fig 1,part #54.also see 5:13]

*Regarding claims 11, &27* the method of claim 8, wherein the act of communicating comprises communicating by a computer network.[Apfel 5:5-10]

*Regarding claims 12,&28* the method of claim 8, wherein the act of communicating comprises communicating with a database server device.[Apfel abstract, fig2 Part# 80b]

*Regarding claims 13&29* the method of claim 1, determining comprises comparing at least one characteristic of the first identified first version of the software module with the same characteristic of the second identified first version of the software module. [Apfel *abstract* see date, also see fig 4a part# 406].

*Regarding claims 14 &30* the method of claim 1, indicating comprises visually displaying an indication of the software module determined to be the most current version to a user.[Apfel see 10:23-28, also see fig4a part# 409]

*Regarding claims 15, & 31* the method of claim 2, wherein the act of obtaining comprises retrieving that version of the software module determined to be the most current version from an update source.(Apfel 11:66-67, also 7:18-20 for compatibility of upgrades)

*Regarding claims 16, &32* the method of claim 15, wherein the act of retrieving comprises retrieving from an update source that is physically distinct from the location of the first identified version of the software module.[Apfel abstract, see server, also see part# 451 from fig 4b]

*Regarding claim 41* (new claim) method of claim 1,wherein determining comprises: determining a date associated with the first version, the date establishing compatibility between second and first.[see abstract, also refer to part #406 from fig 4a].

Regarding 41 according to claim 1, circuitry comprising an add-in card. [ hardware device as taught in applicants specification page, 4 lines 21-22, see Furner 7: 55-57].

*Regarding claim 43 (new claim) see reasoning in claim 41.*

*Regarding claim 44 (new claim) see reasoning in claim 42.*

Claims 7,23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al .US-PAT-NO: 5974454 hereinafter Apfel as applied in claim 4 in view of of Furner et al. USPN 5,974,474 hereinafter Furner and in further view of admitted prior art.

*With regards to claims 7, & 23 Apfel as modified by Furner as applied in claim 4 discloses all the claimed limitations. Apfel as modified by Furner doesn't explicitly disclose determining a basic input-output system version identifier value of the physical device. However, applicants disclosure admits that determining a basic input-output system version identifier value of the physical device is old and well known.[page 1.lines 10-18]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Apfel as modified by Furner and admission to update the BIOS because, obtaining BIOS information during upgrading/updating is a common practice.*

3.

***This action is made Final.***

Applicant's arguments are not persuasive to overcome 35 U.S.C. § 102(a) or 35 U.S.C. § 103(a) as discussed per, prior art with previous cited reference **Apfel et al.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Art Unit: 2122

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. see MPEP § 706.07 (a).

*Correspondence Information*

Any inquires concerning this communication or earlier communications from the examiner should be directed to Chuck O. Kendall who may be reached via telephone at (703) 308-6608. The examiner can normally be reached Monday through Friday between 8:00 A.M. and 5:00 P.M. est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Greg Morse* can be reached at (703) 308-4789.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*For facsimile (fax) send to 703-7467239 official and 703-7467240 draft*

*Chuck O. Kendall*

*Software Engineer Patent Examiner  
United States Department of Commerce*

*Gregory A. Morse*  
GREGORY A. MORSE  
PRIMARY EXAMINER